

REMARKS**Summary of the Office Action**

The Office Action alleges, at page 2 that no certified copy of the priority document has been received in this application.

Claims 1-8 stand rejected under 35 U.S.C. 102(e) as being anticipated by Beak (U.S. Patent Application Publication No. 2004/00119788) (hereinafter "Beak").

Claims 1, 2, 4, 6, 7 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yamazaki et al. (U.S. Patent No. 6,955,953) (hereinafter "Yamazaki").

Summary of the Response to the Office Action

Applicant has amended claim 1 to differently describe embodiments of the disclosure of the instant application and to include features of previous dependent claim 6. Accordingly, claim 6 has been canceled without prejudice or disclaimer and the dependencies of claims 7 and 8 have been amended accordingly. As a result, claims 1-5 and 7-23 currently remain pending with claims 1, 2, 4, 5, and 7-9 currently under consideration.

Priority Document Issues

The Office Action alleges, at page 2 that no certified copy of the priority document has been received in this application. Applicant respectfully traverses this assertion because it is currently Applicant's understanding that the certified copy of the Japanese priority document (JP P2004-012967, filed in Japan on January 21, 2004) has been received in this national stage application from the International Bureau in accordance with PCT Rule 17.2(a). See the Form PCT/DO/EO/903 (371 Acceptance Notice) form that was mailed on June 23, 2008 which

indicates that the priority document has been received. Accordingly, it appears that section 12)a)3. should have been checked in section 12 of page 1 of the Office Action (PTOL-326 Form). As a result, acknowledgement of receipt of the certified copy of the Japanese priority document for this application is respectfully requested. To the extent that any of Applicant's understandings are incorrect in these regards, specific clarification is requested to be provided by the Examiner in the next Office Communication.

Rejections under 35 U.S.C. § 102(e)

Claims 1-8 stand rejected under 35 U.S.C. 102(e) as being anticipated by Beak. Claims 1, 2, 4, 6, 7 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yamazaki. Applicant has amended claim 1 to differently describe embodiments of the disclosure of the instant application and to include features of previous dependent claim 6. Accordingly, claim 6 has been canceled without prejudice or disclaimer and the dependencies of claims 7 and 8 have been amended accordingly. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicant has newly-amended independent claim 1 to describe an advantageous combination of features including “wherein each of the first electrode terminal and the second electrode terminal has a surface area such that a metal probe can make contact therewith.”

Applicant respectfully submits that the present invention is directed to a semiconductor apparatus in which a defect within the protective film 17 is detected through measurement of electrical conduction between the first conductive layer 16 and the second conductive layer 18. See, for example, page 11, line 19 – page 12, line 1 of the specification and Fig. 1 of the instant application.

Applicant respectfully submits that for the purpose of defect detection, the first conductive layer 16 is electrically connected with a first electrode terminal 19A (see, for example, page 7, lines 14-17) and the second conductive layer 18 is electrically connected with a second electrode terminal 19B (see, for example, page 7, lines 22-24).

Additionally, Applicant notes that each of the first electrode terminal (19A) and the second electrode terminal (19B) has a surface area such that a metal probe (20A, 20B) can make contact therewith (claim 1). In this regard, please refer to Fig. 1 and the corresponding descriptions in the specification, for example, "[t]his first electrode terminal 19A has a surface area such that a metal probe 20A intended for defect detection can make contact with the terminal 19A" and "[t]his electrode terminal 19B has a surface area such that a metal probe 20B intended for defect detection can make contact with the terminal 19B." See, for example, page 7, lines 17-26 of the specification of the instant application. Applicant respectfully submits that the first and second probes 20A and 20B are connected to a detector 21 for performing defect detection. See, for example, page 7, line 27 – page 8, line 1 of the specification of the instant application.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 102(e) should be withdrawn because neither Beak nor Yamazaki anticipate, teach or suggest each feature of the specific configuration described in independent claim 1 of the instant application, as newly-amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

Furthermore, Applicant respectfully assert that the dependent claims are allowable at least because of their dependence from independent claim 1, and the reasons discussed previously.

CONCLUSION

In view of the foregoing, Applicant submits that the claims under consideration are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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